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In re application of	:	
Krukonis et al.	:	DECISION ON
Serial No. 10/623,006	:	PETITION
Filed: July 18, 2003	:	
For: REDUCTION OF CONSTITUENTS IN TOBACCO	:	

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION, dated October 25, 2006.

On November 23, 2005, a non-final Office action was mailed to applicants. The Office action contained rejections under 35 USC 102 (b) and 103 (a) over Niven, Jr. et al. A reply to the Office action was filed on February 23, 2006. In the reply, various amendments to several of the claims including independent claim 1 were made. The amendments overcame the rejections to the claims over the Niven, Jr. et al. reference. Amendments added to independent claim 1 included a limitation requiring that the amount of constituent in the tobacco be dissolved in the subcritical fluid.

On April 25, 2006, a final Office action was mailed. All of the previous grounds of rejection were withdrawn and several new grounds of rejection were added which included a 35 USC 103 (a) rejection of the claims over newly cited art to Garner. The examiner stated in the office action that the new grounds of rejection were necessitated by Applicant's amendments to the claims and the Office action was made final. On September 25, 2006, Applicant submitted arguments against the art rejections and the finality of the April 25, 2006 office action. On October 13, 2006, the examiner send out an Advisory Action addressing the applicant's arguments. On October 25, 2006, the present petition was filed.

Petitioner has argued that the finality of the last Office action is improper. Petitioner argues that the new grounds of rejection were not necessitated by Applicant's amendments and further, that the claims were amended in a manner that could have been reasonably expected by the scope of the specification.

DECISION

The amendment to the claims requiring that the amount of constituent in the tobacco be dissolved in the subcritical fluid presented a limitation that was not present in the Niven, Jr. et al. reference thereby overcoming the rejections applied in the non-final rejection. It is noted that both of these claims were properly rejected over the Niven, Jr. et al. reference. It is clear that the

examiner withdrew the aforementioned rejections of all of the claims due to the amendments presented.

As set forth in the petition, the standard for making an Office action final is set forth in section 706.07(b) of the MPEP which states:

A second or any subsequent action on the merits in any application...should not be made final if it includes a rejection, on prior art of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

In this case, the amendments presented could not have been reasonably expected by the examiner. The examiner would have no way of anticipating that such a limitation (i.e. that the amount of constituent in the tobacco is dissolved in the subcritical fluid) would be presented. Thus, even though the newly presented limitations narrowed the scope of the claims, all of the original claimed were properly rejected under 35 USC 102 (b) as well as 35 USC 103 and the amendments presented necessitated the new grounds of rejection because the examiner would not have reasonably expected such limitations to be claimed. Accordingly, the examiner properly made the April 25, 2006 Office action final.

The Petition is **DENIED**.

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